REMARKS

Section 101 Rejection

The Office Action rejected claims 1-20 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter since the "user interface and database are software constructs must be embedded on or along with a tangible medium to satisfy the intent of this statute". These claims have been amended to overcome the rejection. Withdrawal of the rejection is requested.

Section 112 Rejection

Claims 1-20 were rejected under 35 U.S.C. 112, second paragraph as the "system" as claimed was asserted to be indefinite. These claims have been amended to overcome the rejection. Withdrawal of the rejection is requested.

Section 102 Rejection

Claims 1-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Unlock the Value of Intellectual Assets, McKinsey & Company (McKinsey). The Office Action asserted that

> The applicant has interpreted the system to read on computer terminal. Applying the art to the instant claims, the "online market" (page 3) of the prior art, inherently possessing a user interface and a database, anticipated the claimed apparatus. The prior art also anticipated Claims 2-7 which only require an interface. Claim 9-12, and 13 reads on a chat room to which the examiner takes official notice exist in internet market places.

Applicant respectfully traverse the rejection. For a Section 102 rejection, MPEP § 2131 provides that:

> A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." Verdegaal Bros. v. Union Oil Co. Of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

Here, the rejection is improper since the prior art reference relied upon by the examiner in a § 102 rejection does not contain every element recited in the claim in as complete detail as is contained in the claim and arranged as recited in the claim. No

where in McKinsey does it show the claimed specifics of a system to support trading of intellectual property (IP), comprising a processor; a user interface displayed by the processor to accept a request to trade an IP asset; and a database coupled to the user interface and to the processor to store data associated with one or more IP assets, the database supporting the trading of the IP asset. Withdrawal of the rejection is requested.

Next, McKinsey is not prior art to the instant application, which has a filing date of April 25, 2001 and claims priority from Provisional Application No. 60/200,962, filed on May 1, 2000. McKinsey was published afterward.

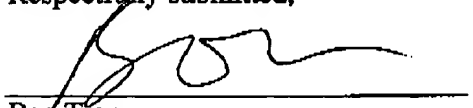
As to the Examiner's inherency argument, Appellant notes that the Examiner must provide rationale or evidence tending to show inherency. M.P.E.P. § 2112. The fact that a certain result may occur in the prior art is not sufficient to establish inherency of that result. *Id.* As the court noted in *In Re Roberston*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999)

> To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. Inherence, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In the instant case, the Examiner has not provided any rationale or evidence in the reference showing system to perform the claimed specifics, and the rejection should be withdrawn for this reason.

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at (408) 528-7490 or fax at (408) 528-1490.

Respectfully submitted,



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